

REMARKS

STATUS OF THE CLAIMS

Claims 1-19 are presently pending and stand variously rejected under 35 U.S.C. §§ 112, 102 and 103. Claim 1 has been amended to make clear antecedent basis for the term "junction member." Thus, claims 1-19 are pending as shown above. The foregoing amendments are made solely to expedite prosecution. No new matter has been added as a result of this amendment and entry thereof is respectfully requested.

REQUEST TO WITHDRAW FINALITY

Applicants respectfully request that the Office withdraw the finality of this Office Action and issue another non-final Office Action in this case. This request is made because the newly presented rejections were not necessitated by Applicants' previous amendments.

As indicated in M.P.E.P. 706.07(a), final rejection is not proper when it is neither necessitated by Applicants' amendments nor based on information submitted in an IDS. In the pending case, Applicants' previous amendments made explicit what was previously implicit. Therefore, there is absolutely no reason that the rejections newly-presented in the Final Office Action mailed January 14, 2004 could not have been made previously. In other words, Applicants' amendments did not necessitate the newly presented rejections. Accordingly, Applicants herein request that the outstanding Office Action be considered non-final and this response treated accordingly.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-19 were rejected as allegedly indefinite for failing to provide proper antecedent basis for the term "junction member." (Final Office Action, page 2). Applicants have amended independent claim 1 as shown above to obviate this rejection and to make clear that each junction comprises a junction member that is severable by the application of a different wavelength of light. Accordingly, withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 6 and 10 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,807,404 (hereinafter "Richter"). Richter is alleged to teach a stent having at least two "junction members" with a plurality of "detachment junctions" that are fully capable of being leaved by the application of a different wavelength of electromagnetic radiation. Final Office Action, pages 2-3.

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Claims 1, 6 and 10 are drawn to devices having multiple detachment junctions and in which each detachment junction is cleaved by a different wavelength of light than the others. Richter is completely silent as to devices that include detachment junctions and, moreover, to the use of electromagnetic radiation to cleave such junctions. Richter relates to expandable stents. There is nothing in this reference indicating that the stents having junctions that allow them to be cleaved at multiple points along their length, let alone where each junction is cleaved by the application of different wavelength of light. Richter discloses only that various regions of the stents have different flexibility than other regions. *See*, FIG. 2 and col. 6, lines 46-65 describing how flexibility of U-shaped elements such as 9 and 9' can be changed. Flexibility is not related to detachability -- the former assumes the devices stays whole whereas the latter contemplates cleavage of the device at various points. Thus, contrary to the Examiner's assertion, the flexible portions of Richter's stent (namely elements 9 and 9' of FIG. 2) are not detachment junctions -- they are not designed or used to cleave the stent along its length.

Should the Examiner be somehow asserting the changes in flexibility of these regions inherently make them capable of being cleaved by different wavelengths of light, Applicants note that it is well established that, under the doctrine of inherency, a reference can anticipate a claim if and only if the missing element is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Rosco Inc. v. Mirror Lite Co.*, 64 USPQ2d 1676 (Fed. Cir. 2002) citing *Cont'l Can Co. v. Monsanto Co.*, 20 USPQ2d 1746 (Fed. Cir. 1991). In other words, inherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 63 USPQ2d 1597 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)).

In the pending application, the devices of claims 1, 6 and 10 must not only have multiple detachment junctions, each of these detachment junctions must also each be cleavable by different wavelengths of light. Thus, the question is not whether Richter disclose devices having regions of different flexibility or how these regions are made more flexible, but whether one skilled in the art would read this reference as necessarily disclosing devices that have multiple cleavable junction members, as claimed. In point of fact, there is absolutely no evidence in the record to support a finding that one skilled in the art would so read Richter. Nowhere does Richter teach or suggest devices that are cleavable at multiple locations, let alone devices having multiple detachment points, where each is detached by the application of a different wavelength of light. Altering flexibility of a device in particular regions has no relevance to cleaving a device by application of light at a pre-selected point.

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The anticipation rejections based on alleged inherency are also improper because no evidence has been offered by the Office supporting the assertion that any and all devices having regions of altered flexibility would necessarily be capable of being cleaved by the application of different wavelengths of light. As the Board of Patent Appeals and Interferences and Federal Circuit have repeatedly established, "the examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic" of the reference. *Ex parte Skinner*, 2 USPQ2d 1788 (BPAI 1986), emphasis added. The Office has provided no such evidence or reasoning, but, instead, has merely asserted that any reference related to devices having different flexibilities along its length inherently discloses the particularly claimed invention of claims 1, 6 and 10. In fact, Richter fails entirely to describe or demonstrate detachment junctions that are cleaved by different wavelengths of light. In the absence of any evidence supporting inherency and the abundance of evidence against inherency, Applicants submit that the rejection is improper and should be withdrawn. In the event that the Examiner continues to maintain these unsupported rejections, Applicants request, pursuant to 37 C.F.R. § 1.104(d)(2), that the Examiner support this rejection with an affidavit.

In sum, because Richter fails entirely to necessarily disclose or describe the devices as recited in the claims (multiple detachment junctions, each cleaved by the application of a different wavelength of light), this reference cannot anticipate any of the pending claims and withdrawal of the rejections is in order.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 2, 3, 5, 7-9, 11, 13, 15 and 16 as allegedly obvious over Richter in view of U.S. Patent No. 6,086,599 (hereinafter "Lee"). Furthermore, claims 4, 12, 17-19 stand rejected as allegedly obvious over Richter in view of Lee and in further view of U.S. Patent No. 6,102,917 (hereinafter "Maitland").

Richter is cited as above. Lee is cited for teaching a coil device having a plurality of detachment junctions. (Final Office Action, page 3). Maitland is cited, *inter alia*, for teaching that the laser energy can be applied via an optical coil. (Final Office Action, page 4). With regard to claims 2, 3, 5, 7-9, 11, 13, 15 and 16, it is alleged that it would have been "obvious to one of skill in the art to use a SMP or a coil as taught by Lee for the device and assembly of Richter in order to reduce the radiopactiy of the device by using a SMP and provide a simpler device such as a coil." (Final Office Action, page 3). Claims 4, 12, and 17-19 are alleged to be

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obvious in view of Maitland's disclosure of transmission via optical fibers. (Final Office Action, page 4).

Because a *prima facie* case of obviousness has not been, and indeed cannot be, established, Applicants traverse the rejection.

The cited references do not teach or suggest all the elements of the pending claims. For the reasons detailed above, Richter is completely silent as to devices that have multiple detachment junctions. Instead, his stents are expandable and have regions of differing flexibility to reduce end flaring. There is no disclosure or suggestion in Richter of a device that can be cleaved in multiple locations, as claimed. Accordingly, it is impossible for this reference to suggest devices (1) having multiple detachment junctions; (2) in which detachment at these junctions by the application of light; and/or (3) in which each of the multiple detachment points is cleaved by the application of a different wavelength of light. Not only does Richter fail to teach all the elements as claimed, it simply fails to teach a device including any of the claimed elements. There is simply nothing in this reference regarding the devices as set forth in the claims.

For the reasons of record, Lee and Maitland fail to cure the utter deficiency of Richter. Lee refers to the use of junction members wherein each junction member has the same light-activation properties. (*See, e.g.*, claim 1 and col. 4, lines 8 to 18 of Lee). Thus, there is no combination of Richter, Lee and Maitland that would lead one of skill in the art to the claimed devices. Accordingly, Applicants request that this rejection be withdrawn.

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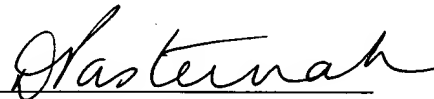
CONCLUSION

For the reasons discussed above, Applicants submit that the claims are in condition for allowance and request early notification to that effect.

If the Examiner has any further issues or wishes to discuss any of the foregoing, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date: February 18, 2004

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